

REMARKS

Claims 18, 19, and 22-38 are pending in the present application and stand rejected. Applicant has cancelled claims 1-17. Applicant has amended the specification and claim 22 in accordance with the 37 C.F.R. 1.71 objection and the 35 U.S.C. 112, first paragraph rejection. Claims 18, 19, and 22-36 have been amended to more clearly and specifically set forth the subject matter which Applicant regards as the invention.

Applicant respectfully requests reconsideration and allowance of the application in view of the included amendments and the following remarks.

Double Patenting

In regard to the provisional rejection of claims 18, 23-28, 31 and 33 under the judicially created doctrine of double patenting over the claims of co-pending Application No. 09/206,720, Applicant plans on filing a terminal disclaimer after the patent based on Application No. 09/206,720 issues. Accordingly, Applicant respectfully requests that this rejection be held in abeyance until a patent based on Application No. 09/206,720 issues.

§ 102(b)- Stevenson 4,337,963

In regard to the rejection of claims 18 and 24, Applicant respectfully traverses this rejection because Stevenson does not disclose each and every element required by the claims. Stevenson teaches a cast or molded skateboard formed of a top piece and a bottom piece, each of the pieces having intersecting lattice-work, that when fitted together, form a honeycomb-like cellular core. In contrast, the claims recite a method of manufacturing a skateboard including, among other things, extruding a metal board with one or more longitudinally elongated continuous closed cavity forming sections generally running from the front end to the rear end of the board. Stevenson implicitly teaches away from extruding a metal board because the complex honeycomb design of Stevenson could not feasibly be extruded.

Therefore, Applicant respectfully submits that claims 18 and 24 are not anticipated by Stevenson and request that this rejection be withdrawn.

§102(b) – Evancho

In regard to the rejection of amended claims 34-36 as being anticipated by Evancho, Applicant respectfully traverses this rejection because Evancho does not disclose each and every element required by the claims. Amended claims 34-36 require the elongated metal board have one or more longitudinally elongated continuous closed cavity forming sections generally running from the front end to the rear end of the board and be shaped into a form suitable for a skateboard. Evancho relates to the manufacture of bumpers for automobiles, not the manufacture of skateboards, especially skateboards including one or more longitudinally elongated continuous closed cavity forming sections generally running from the front end to the rear end of the board.

Therefore, Applicant respectfully submits that amended claims 34-36 are not anticipated by Evancho and request that this rejection be withdrawn.

§103(a) – Ellett in view of Mayr:

In regard to the rejection of claims 18 and 24 as being unpatentable over Ellett in view of Mayr, Applicant respectfully traverses this rejection because neither Ellet nor Mayr disclose, teach or suggest a method for manufacturing a skateboard. Thus, the combination of Ellett and Mayr would not achieve a method for manufacturing a skateboard.

Ellet describes a snow ski attached to a ski bike and Mayr teaches a snow ski. In contrast, the amended claimed invention recites a method for manufacturing a metal skateboard. Neither a ski bike nor a snow ski disclose, teach or suggest a skateboard. Skateboards are adapted to be mounted on wheels, for the purpose of being ridden on a hard surface such as cement or pavement, and are adapted to be ridden with both of the rider's feet extending generally perpendicular to the longitudinal axis of the board. The ski of Mayr and the ski bike of Ellet are designed to glide down snow-covered hills. The snow ski taught by Ellett is further designed to be attached to a snow bike ridden in a sitting position, not to be ridden by a standing person whose feet extend generally perpendicular to the longitudinal axis of the board. Furthermore, the shape of the skis in Ellet and Mayr are not suitable for a skateboard, as the amended claims recite. The Ellet and Mayr ski is in a shape suitable for a snow ski, with an exaggerated up-turned front end, and straight back end which is preferable for gliding down snow covered hills. The amended claims recite a shape suitable for a skateboard, which traditionally encompasses equally up-turned front and back ends.

Therefore, Applicant respectfully submits that claims 18 and 24 are not obvious over Ellett in view of Mayr because the combination of Ellett and Mayr does not achieve the claimed method for manufacturing a skateboard. Applicant respectfully requests that this rejection be withdrawn.

§103(a) - Stevenson in view of Evancho:

In regard to the rejection of claim 19 as being unpatentable over Stevenson in view of Evancho, Applicant respectfully traverses this rejection because, as discussed above, Stevenson implicitly teaches away from extruding. Further, Evancho relates to the manufacture of automobile bumpers, not skateboards. Thus, proper motivation does not exist to combine these references. Applicant respectfully requests that this rejection be withdrawn.

§103(a) – Ellett in view of Mayr, Evancho

In regard to the rejection of claims 19 and 23 as being unpatentable over Ellett as modified by Mayr and further in view of Evancho, Applicant respectfully submits that these claims are not obvious for the reasons given above with respect to Ellett in view of Mayr. The combination of the cited references does not disclose, teach or suggest a method of manufacturing a skateboard. Further, proper motivation does not exist to combine Evancho with Ellett and Mayr because the references are in non-analogous arts (manufacture of automobile bumpers versus snows skis).

Therefore, Applicant respectfully submits that claims 19 and 23 are not obvious over Ellett as modified by Mayr and further in view of Evancho because the combination does not achieve the claimed invention and proper motivation does not exist to combine these references.

§103(a) – Stevenson in view of Le Masson

In regard to the rejection of claim 22 as being unpatentable over Stevenson in view of Le Masson, Applicant respectfully traverses this rejection because, as discussed above, Stevenson implicitly teaches away from extruding. Further, proper motivation does not exist to combine these references because Le Masson relates to skis, not skateboards.

Therefore, Applicant respectfully submits that claim 22 is not obvious over Stevenson in view of Le Masson and respectfully requests that this rejection be withdrawn.

New Claims 37-38:

*See
parent #11
in the
parent
application
FEB
5/8/00*

Pursuant to the February 16, 2000 interview with Examiner Vanaman, Applicant has rewritten method claims 26 and 27 from the parent application (U.S. Application No. 09/206,720) as new claims 37-38 in the present application to keep all the method of manufacturing claims in this case. These claims were indicated as being allowable in an office action of October 25, 1999. The only difference between claim 37 and claim 26 from the parent application is that the word "hollow" is deleted from line 3 of claim 26.

CONCLUSION

On the basis of the above amendments, reconsideration and allowance of the application is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments regarding this amendment, he is respectfully urged to contact the undersigned at the number listed below.

Date: February 24, 2000

Respectfully submitted,

LYON & LYON LLP


By: _____

Stephen C. Beuerle

Reg. No. 38,380

633 West Fifth Street, 47th Floor
Los Angeles, CA 90071-2066
(858) 552-8400